

REMARKS

I. STATUS OF CLAIMS

Claims 1, 3, 6-38, and 41-44 are pending. Claims 20-28 and 41-44 are withdrawn from consideration. Claim 2 was previously canceled. Claim 1 herein is amended to include the recitations of claims 4 and 5, which are canceled. Claim 38 is amended herein to include the recitations of claims 39 and 40, which are canceled. Claims 6-8, 10, 11, 13, and 14 are amended to change the dependency to claim 1 in view of the cancellation of claims 4 and 5. The specification as filed and the original claims provide written description support for the claim amendments. Their entry is respectfully requested.

II. REJECTIONS UNDER 35 U.S.C. § 103

A. Rejection of Claims 1, 3-19, and 29-32

Claims 1, 3-19, and 29-32 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 4,150,216 to Quack et al. ("Quack") in view of U.S. Patent No. 5,164,177 to Bhatt et al. ("Bhatt"). Office Action at p. 3. Applicants traverse the rejection for the reasons of record and the additional reasons set forth below.

In order to establish a *prima facie* case of obviousness, the Examiner first must show that the prior art references teach or suggest all the claim limitations. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970)(holding that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art."). Here, the Examiner has not met that burden because Quack and Bhatt fail to teach or suggest all the elements of the present claims. Specifically, Quack and Bhatt fail to teach or suggest a composition comprising at least one branched sulphonic

polyester formed by polymerizing the components as defined in the independent claim 1.

Quack is directed to film-forming hair treatment agents. See Quack at col. 1, lines 49-54. Quack discloses that known polymer film-formers usually have the disadvantage of high water absorption at elevated atmosphere humidity, which, *inter alia*, results in the hair sticking together in an undesired manner and in a loss of firmness with consequent collapse of the hair style. See *id.* at col. 1, lines 32-37. Yet, Quack found that “branched copolymers dispersible or soluble in water, having an apparent molecular weight of between approximately 600 and approximately 5000 and a content of SO₃M groups are ideally suited to the production of film-forming hair-treatment agents.” *Id.* at col. 1, lines 49-54. Indeed, Quack teaches that hair treatment agents based on these branched sulfo group-containing polyesters have very low water absorption especially at high atmospheric humidity. *Id.* at col. 1. at lines 58-68.

To achieve low water absorption, the hair treatment agents in Quack require a specific branched sulfo group-containing polyesters obtained from:

- 75 mole % isophthalic acid;
- 10 mole % of pyromellitic anhydride;
- 15 mole % of 5-sodiumsulfonatoisophthalic acid dimethyl ester, and
- 100 mole % of diethylene glycol apparent molecular weight 700 to 1000.

See *id.* at col. 2, lines 11-40, Table 1. However, the branched sulphonic polyester of Quack differs from, and does not meet the limitations of, the branched sulphonic polyester included in the claimed composition. While Quack’s branched sulphonic

polyester comprises at least one difunctional dicarboxylic acid having no sulphonic functional groups (isophthalic acid), at least one difunctional monomer having at least one sulphonic group (sodiumsulfonatoisophthalic acid dimethyl ester), at least one diol (diethylene glycol), and at least one multifunctional reagent (pyromellitic anhydride), it fails to include at least one difunctional monomer chosen from hydroxycarboxylic acids and aminocarboxylic acids.

Moreover, based on the teachings of Quack one of ordinary skill would not form a branched sulphonic polyester that includes at least one difunctional monomer chosen from hydroxycarboxylic acids and aminocarboxylic acids. Indeed, to do would mean proceeding contrary to the teachings of Quack -- altering the specific branched sulfphonic polyesters that are essential to providing the advantages, e.g., very low water absorption especially at high atmospheric humidity, to its hair treatment agents. See Quack at col. 1, line 66 to col. 2, line 40; see also M.P.E.P. § 2145 (The totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness).

Bhatt does not cure the deficiencies of Quack, nor does the Examiner allege that it does. Indeed, the Examiner relies on Bhatt for teaching a composition comprising a non-volatile silicone in an amount of 0.05-4% by weight. Office Action at p. 3.

In summary, Quack and Bhatt fail to teach or suggest all the claim limitations, therefore the Examiner failed to establish that independent claim 1 or the claims depending therefrom, are *prima facie* obvious based on these cited references. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

B. Rejection of Claims 33-40

Claims 33-40 are rejected under 35 U.S.C. § 103(a) over Quack in view of Bhatt and further in view of U.S. Patent No. 5,320,836 to Singleton et al. (“Singleton”). Office Action at p. 4. Applicants traverse each of the § 103 rejections for the reasons of record and the additional reasons set forth below.

Claims 33-37 depend from claim 1. Independent claim 38 is directed to an aerosol device comprising, *inter alia*, the cosmetic composition as defined in claim 1.

As discussed above, Quack and Bhatt fail to teach a composition comprising a branched sulphonic polyester as defined in independent claim 1, e.g., a composition comprising at least one branched sulphonic polyester comprising, *inter alia*, at least one difunctional monomer chosen from hydroxycarboxylic acids and aminocarboxylic acids. Singleton does not cure the deficiencies of Quack or Bhatt, nor does the Examiner allege that it does. Indeed, the Examiner asserts that Singleton teaches a composition comprising a propellant. Office Action at p. 4. Therefore, the Examiner failed to establish that independent claims 1 and 38 or the claims depending therefrom, are *prima facie* obvious based on these cited references. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection under 35 U.S.C. § 103(a).

III. DOUBLE PATENTING REJECTIONS

The Examiner sets forth three obviousness-type double patenting rejections:

1. Claims 1, 3-19, and 29-40 are rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1, 14-24, 26-27, and 29 of U.S. Patent No. 6,039,933 (“the ‘933 patent”).

2. Claims 1, 3-19, and 29-40 are rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1-22 of U.S. Patent No. 6,692,730 ("the '730 patent").
3. Claims 1, 3-19, and 29-40 are rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1-19 of U.S. Application No. 10/320,707 ("the '707 application").

Office Action at pages 5, 6, and 7. Applicants respectfully disagree and traverse each of the rejections for at least the followings reasons.

While the compositions disclosed in the '933 patent, the '730 patent, and the '707 application may be "similar" to the claimed compositions, as asserted by the Examiner, similarity is not enough to establish obviousness. Moreover, Applicants submit that none of the claims in the '933 patent, the '730 patent, or the '707 application recite a composition comprising at least one branched sulphonic polyester as defined in independent claims 1 or 38. Accordingly, the Examiner failed to establish that claims 1, 3, 6-19, and 29-38 are obvious based on any of the claims of the '933 patent, the '730 patent, or the '707 application.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw each of the foregoing rejections.

IV. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 22, 2010

By: Jennifer Gupta
Jennifer R. Gupta
Reg. No. 54,257